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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92061845
Party	Defendant Thomas Koenig
Correspondence Address	THOMAS KOENIG 43 SHOAL DRIVE EAST, VALLEJO, CA 94591 UNITED STATES
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Date	11/20/2015
Attachments	DATUM Motion for Relief, Declaration, Answer Serial 85833180.pdf(464774 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

Datum Group LLC,

Petitioner,

v.

Thomas Koenig,

Registrant.

Mark: DATUM and design

Registration No.: 4490434

Proceeding No.: 92061845

Date of Registration: March 4, 2014

**MOTION FOR RELIEF FROM FINAL JUDGMENT AND MOTION FOR LEAVE TO
FILE LATE ANSWER**

Registrant Thomas Koenig by its undersigned attorneys, submits the herein pursuant to 37 C.F.R. § 2.116(a) and Fed. R. Civ. P. 60(b) Motion for Relief from Final Judgment and Motion for Leave to File a Late Answer in this proceeding.

I. Statement of Facts

Registrant, Thomas Koenig, is a businessman that frequently travels internationally, particularly throughout Asia. *See* Declaration of Thomas Koenig (“Koenig Decl.”), ¶ 3. Registrant Koenig maintains a residence in the United States at 43 Shoal Drive East Vallejo, CA 94591. Koenig Decl. ¶ 2. Registrant Koenig’s mail at the Vallejo, CA address is forwarded to a residence at 638 Paseo Companeros, Chico CA 95928. Koenig Decl. ¶ 4. All mail received at this address is sorted, stored, and subsequently forwarded to Registrant’s Koneig’s current location. Koenig Decl. ¶ 4.

On July 14, 2015, Petitioner filed a Petition to Cancel Registrant Koenig's trademark registration No. 4490434. This Petition to Cancel included a Notice of Service page indicating that the Petition was mailed via first class, postage paid U.S. Mail to the following address:

Koenig, Thomas
43 Shoal Drive East
Vallejo, California 94591

Registrant did not receive the Petition to Cancel at either his Vallejo, CA or Chico CA addresses.

Koenig Decl. ¶ 5. Registrant Koneig, in fact, never received *any* mailings in regards to the Cancellation proceeding at either the Vallejo, CA address or the Chico, CA address. Koenig Decl. ¶ 5 - 14. Registrant therefore was not aware of the Petition to Cancel, nor the Board's subsequent Notice mailed on July 16, 2015 initiating the proceeding and setting the deadline for Registrant to timely file in Answer. Solely because Registrant was unaware of the issue, Registrant did not respond. Koenig Decl. ¶ 15.

Subsequently, the Board issued a Notice of Default judgment on September 4, 2015. Registrant did not receive this mailing at either his Vallejo, CA or Chico CA addresses. Koenig Decl. ¶ 7. Solely because Registrant was unaware of the issue, Registrant did not respond. Koenig Decl. ¶ 15.

Thus, on October 14, 2015, because no response from Registrant was filed, the Board entered judgment by default against Registrant and granted Petitioner's Petition to Cancel Registration No. 4490434.

Registrant did not receive any mailings in regards to the current Cancellation proceeding, and therefore Registrant did not become aware of the Cancellation proceeding until very recently. Registrant Koenig was not aware of the existence of the Cancellation proceeding until checking the status of his trademark registration online. At that time Registrant Koenig was

surprised to see that the Registration had been cancelled, and subsequently reached out to the law firm of Raj Abhyanker, P.C. for information regarding the status of the trademark, wherein he was informed about the details of the Cancellation proceeding.

Had Registrant been made aware of the pending Cancellation matter, Registrant would have timely filed an Answer to the Petition for Cancellation. Koenig Decl. ¶ 15. Registrant, however, was not so made aware and therefore was unable to properly respond to the Petition to Cancel.

II. Legal Argument

Motions for Relief from final judgments issued by default by the Trademark Trial and Appeal Board are governed by Federal Rule of Civil Procedure 60(b). 37 CFR § 2.116(a); Trademark Trial and Appeal Board Manual of Procedure § 544. Under Rule 60(b), a court may relieve a party from a final judgment for one of the following reasons:

- (1) mistake, inadvertence, surprise, or excusable neglect;
- (2) newly discovered evidence that, with reasonable diligence, could not have been discovered in time to move for a new trial under Rule 59(b);
- (3) fraud (whether previously called intrinsic or extrinsic), misrepresentation, or misconduct by an opposing party;
- (4) the judgment is void;
- (5) the judgment has been satisfied, released, or discharged; it is based on an earlier judgment that has been reversed or vacated; or applying it prospectively is no longer equitable; or
- (6) any other reason that justifies relief.

Fed. R. Civ. Pro. 60(b).

Although relief from a final judgment is “an extraordinary remedy”, the determination as to whether such a motion should be granted lies with the Board. Due to the fact default judgments for failure to timely answer the complaint “are not favored by the law”, motions under Rule 60(b) seeking relief from such judgments are “treated with more liberality by the Board

than are motions under Fed. R. Civ. P. 60(b) for relief from other types of judgment.” TMBP § 544. “Rule 60(b) is applied most liberally to judgments in default.” *Information Sys. and Networks Corp. v. United States*, 994 F.2d 792, 795 (Fed. Cir. 1993).

A. Registrant’s Motion is Timely

A motion for relief from final judgment must be made within a reasonable amount of time. For motions for relief made under Rule 60(b)(1)-(3), the filing must be made within one year after which the judgment was granted. For motions for relief under Rule 60(b)(4)-(6), it is within a court’s discretion to determine whether the timing of the motion is reasonable in light of the circumstances.

Registrant’s instant Motion comes less than 30 days from the order granting cancellation of Registrant’s registration. Accordingly, Registrant’s Motion has been filed well within the one year limitation for claims made under Rule 60(b)(1)-(3), and within a reasonable amount of time since the Board’s issuance of a final judgment in the matter.

B. Registrant Should be Granted Relief Under Rule 60(b)(4), as the Board’s Judgment is Void as Registrant Did Not Have Notice of the Proceeding.

Registrant submits that its motion for relief should be granted under Rule 60(b)(4) as the judgment is void due to the failure of Registrant to have notice of the proceeding. When a defendant demonstrates that it received no actual notice of the action before the answer was due to be filed, relief may properly be granted under Rule 60(b)(4). *See Peralta v. Heights Med. Ctr., Inc.* 485 U.S. 80, 85-86 (1988); *Stephenson v. El-Batrawi* 524 F.3d 907, 912-913 (8th Cir. 2008).

Registrant respectfully submits that because it did not receive the Petition to cancel or any documents in relation to this proceeding prior to the issuance of the Board’s default judgment, Registrant did not properly have notice of the proceeding. Registrant has met its burden to support this claim through the attached Declaration of Thomas Koneig, which explains

and provides evidence that Registrant was not aware of the commencement of the proceeding. As a judgment is void where a party did not properly have notice of the proceeding, Registrant respectfully requests that its instant Motion be granted under Rule 60(b)(4).

C. Registrant Should be Granted Relief Under Rule 60(b)(1), as Registrant's Failure to Respond was Caused by Inadvertence and Excusable Neglect.

Registrant further submits that its Motion for relief should be granted under Rule 60(b)(1). Registrant submits that its failure to respond to the Notice of Cancellation was, in any event, caused by at least inadvertence and excusable neglect, given that Registrant was not informed of the proceeding and was not aware that an Answer was in need of filing.

Several factors are to be taken into account when considering whether to vacate a default judgment for failure to answer the complaint, including (1) whether the plaintiff will be prejudiced, (2) whether the default was willful, and (3) whether the defendant has a meritorious defense to the action. *Information Sys.*, 994 F.2d at 795; *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952 (TTAB 1997).

The facts of Registrant's situation clearly warrant that relief from the final judgment should be granted. As only a few weeks have passed since the granting of the final judgment in this manner, it can hardly be said that Petitioner will be prejudiced. To show prejudice, a party must establish that the delay results in a loss of evidence, increased difficulty in discovery, or thwarts the party's ability to obtain relief. *Cutting v. Town of Allenstown*, 936 F.2d 18, 22 (1st Cir. 1991). However, there "is no prejudice to the plaintiff where the setting aside of the default has done no harm to plaintiff except require it to prove its case." *Lacy v. Sitel Corp.* 227 F.3d 290, 293 (5th Cir. 2000). Petitioner's pending trademark applications are still in the *ex parte* review process. Several of Petitioner's applications, in fact, remain suspended as of the filing of this motion. Thus, in effect Petitioner's position is no different currently than it was prior to

issuance of default judgment in this matter. Accordingly, Petitioner will not be prejudiced through the granting of this Motion.

Registrant's failure to respond to the Petition for Cancellation was far from willful. A defendant may show that a default judgment should be set aside where its failure to respond was not caused by devious, deliberate, willful or bad faith failure to respond. When, for example, a party mistakenly places mail in a junk pile, or the mailing becomes lost in a mailroom, a defendant can properly establish that failing to respond was caused by reasonable neglect. *See Standard Enterprises, Inc. v. Bag-It, Inc.*, 115 F.R.D. 38, 39 (S.D.N.Y. 1987); *Owens-Illinois, Inc. v. T & N Ltd.* 191 F.R.D. 522, 527-28 (E.D. Texas 2000). As Registrant was not aware of the Cancellation proceeding, Registrant had no ability to properly respond. Had Registrant been so aware, Registrant would have timely filed a response. Registrant's failure to respond was not a willful or calculated action but was instead caused by, at the very least, inadvertence and excusable neglect. Registrant was highly surprised to learn of the existence of the pending Cancellation upon seeing that its registration had been cancelled.

Finally, Registrant submits that it does have a meritorious defense to the action. In determining whether a meritorious defense exists for the purposes of setting aside a default judgment, a defendant need not show that it *will* prevail, only that there is a *bona fide* chance that such result will occur. The standard is not a likelihood of success; the defendant need only "show that the defense allegations, if proven, would constitute a complete defense. *See Securities & Exchange Comm'n v. McNulty* 137 F.3d 732, 740 (2nd Cir. 1998). Registrant's defenses to action are shown through Registrant's Answer to the Petition for Cancellation, which is being filed in connection with the instant Motion. Petitioner has alleged in its Petition to Cancel only that Petitioner has abandoned use of the mark and that it never in fact used the mark in the U.S. to

offer its products for sale. Registrant has made use of the mark in question to identify its products and has not abandoned use of the mark. Registrant continues to manufacture products in the U.S. under this mark to this very day.

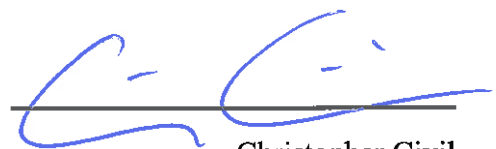
Accordingly, Registrant respectfully submits that its Motion to set aside default judgment in this matter should be granted, as Registrant has demonstrated that its failure to respond was caused, at the least, by inadvertence and excusable neglect, that Petitioner shall not be prejudiced, and that Registrant has a meritorious defense to the claims stated in the Petition to Cancel.

III. Conclusion

For the foregoing reasons, Registrant respectfully requests that the default judgment entered in this matter be set aside, and that leave be granted to Registrant to file a late Answer.

Dated: November 20, 2015

Respectfully Submitted,

A handwritten signature in blue ink, appearing to read 'C. Civil', is written over a horizontal line.

Christopher Civil
Raj Abhyanker, P.C.
451 N. Shoreline Ave
Mountain View, CA. 94043
Tel. 650.390.6384
Fax. 650.989.2131

Attorneys for Registrant

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

Datum Group LLC,

Petitioner,

v.

Thomas Koenig,

Registrant.

Mark: DATUM and design

Registration No.: 4490434

Proceeding No.: 92061845

Date of Registration: March 4, 2014

**DECLARATION OF THOMAS KOENIG IN SUPPORT OF REGISTRANT'S MOTION
FOR RELIEF FROM FINAL JUDGMENT**

I, Thomas Koenig, declare as follows:


1. I am the owner of U.S. trademark registration No. 4490434.
2. I am a citizen of the United States with a residence at 43 Shoal Drive East Vallejo, California 94591.
3. As part of the nature of my business, I frequently travel and live outside of the United States, including in Asia.
4. All mail sent to me at the Vallejo, CA address is forwarded by the U.S. Postal Service to 638 Paseo Companeros, Chico, CA 95928. All mail received at the Chico address is saved and forwarded to me personally to review. Many mailings are received and forwarded successfully to me via this process.
5. I did not receive, review, or was otherwise aware of Petitioner's Petition for Cancellation that was purportedly mailed on July 14, 2015.

14. I did not become aware of the existence of Petitioner's Petition for Cancellation until checking the status of my registration on the Trademark Office's TSDR system on October 26, 2015.

15. I had no knowledge of the pending Cancellation proceeding, nor the Notice of Default issued by the Board. Had I been aware of the existence of the Cancellation proceeding, I would have timely responded to any allegations put forth therein.

I HEREBY DELCARE UNDER PENALTY OF PERJURY
UNDER THE LAWS OF THE UNITED STATES
THAT THE FOREGOING IS TRUE AND CORRECT

Executed on: November 12, 2015


Thomas Koenig

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

Datum Group LLC,

Petitioner,

v.

Thomas Koenig,

Registrant.

Mark: DATUM and design

Registration No.: 4490434

Proceeding No.: 92061845

Date of Registration: March 4, 2014

**REGISTRANT'S ANSWER AND AFFIRMATIVE DEFENSES TO OPPOSER'S
NOTICE OF OPPOSITION**

Registrant, Thomas Koenig, an individual of the United States with an address of 43 Shoal Drive East, Vallejo, CA 94591 ("Registrant"), through its undersigned attorneys, submits its Answer and Affirmative Defenses to the Petition for Cancellation ("Cancellation") filed by Datum Group LLC ("Petitioner") on July 14, 2015 as follows:

In response to the grounds for cancellation enumerated in Petitioner's Electronic System for Trademark Trials and Appeals ("ESTTA") Petition for Cancellation form, Registrant denies that there are any grounds to sustain the cancellation and denies that Petitioner owns any mark(s) sufficient to constitute a basis for this Cancellation.

In response to the first unnumbered paragraph, Applicant admits that the records of the Trademark Status and Document Retrieval ("TSDR") of the United States Patent and Trademark Office ("USPTO") reflect that Registrant owns Reg. No. 4490434. Except as expressly admitted, Applicant denies each and every remaining allegation in the first unnumbered paragraph of the Cancellation.

1. In response to Paragraph 1, Registrant states that it lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 1 and, therefore, denies each and every allegation in paragraph 1 of the Cancellation.
2. In response to Paragraph 2, Registrant admits that the records of the TSDR of the USPTO reflect that Petitioner is the owner of U.S. Serial Nos. 86/047497, 86/497795, and 86/497494. Except as expressly admitted, Registrant denies each and every remaining allegation in the paragraph 2 of the Cancellation.
3. In response to Paragraph 3, Registrant states that it lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 3 and, therefore, denies each and every allegation in paragraph 3 of the Cancellation.
4. In response to Paragraph 4, Registrant admits the allegations in Paragraph 4.
5. In response to Paragraph 5, Registrant admits that the records of the TSDR of the USPTO reflect that Registrant is the owner of U.S. Reg. No. 4490434. Except as expressly admitted, Applicant denies each and every remaining allegation in paragraph 5 of the Cancellation.
6. In response to paragraph 6, Registrant states that it lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 6 and, therefore, denies each and every allegation in paragraph 6 of the Cancellation.
7. In response to Paragraph 7, Registrant denies each and every allegation in paragraph 7 of the Cancellation.
8. In response to Paragraph 8, Registrant denies each and every allegation in paragraph 8 of the Cancellation.

9. In response to Paragraph 9, Registrant denies each and every allegation in paragraph 9 of the Cancellation.
10. In response to Paragraph 10, Registrant denies each and every allegation in paragraph 10 of the Cancellation.
11. In response to paragraph 11, Registrant states that it lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 11 and, therefore, denies each and every allegation in paragraph 11 of the Cancellation.

In response to the final unnumbered paragraph, Applicant denies each and every remaining allegation in the final unnumbered paragraph of the Cancellation.

AFFIRMATIVE DEFENSES

By way of further answer, Applicant alleges and asserts the following defenses in response to the allegations contained in the Notice of Cancellation. In this regard, Registrant undertakes the burden of proof only as to those defenses that are deemed affirmative defenses by law, regardless of how such defenses are denominated in the instant Answer. Registrant reserves the right to assert other affirmative defenses as this Cancellation proceeds based on further discovery, legal research, or analysis that may supply additional facts or lend new meaning or clarification to Petitioner's claims that are not apparent on the face of the Petition for Cancellation.

FIRST AFFIRMATIVE DEFENSE **FAILURE TO STATE A CLAIM**

12. Petitioner's claims are barred because the Petition for Cancellation fails to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE
LACK OF STANDING

13. Petitioner's claims are barred, in whole or in part, because Petitioner does not have standing in that Petitioner does not have rights, superior or otherwise, sufficient to support the Petition for Cancellation.

THIRD AFFIRMATIVE DEFENSE
NO INJURY OR DAMAGE

14. Petitioner's claims are barred, in whole or in part, because Petitioner has not and will not suffer any injury or damage from the continued registration of Registrant's mark

FOURTH AFFIRMATIVE DEFENSE
NO BASIS

15. Petitioner has no basis either in law or fact, to sustain a cancelation of Registrant's mark.

FIFTH AFFIRMATIVE DEFENSE
ACQUIESCENCE

16. Petitioner's claims are barred, in whole or in part, by the doctrine of Acquiescence.

SIXTH AFFIRMATIVE DEFENSE
WAIVER

17. Petitioner's claims are barred, in whole or in part, by the doctrine of Waiver.

SEVENTH AFFIRMATIVE DEFENSE
ESTOPPEL

18. Petitioner's claims are barred, in whole or in part, by the doctrine of Estoppel.

EIGHTH AFFIRMATIVE DEFENSE
STRICT PROOF

19. Registrant calls for strict proof of all of the allegations against Applicant.

NINETH AFFIRMATIVE DEFENSE


Registrant reserves the right to assert any and all other affirmative defenses of which it becomes aware during the pendency of this matter.

WHEREFORE, Registrants requests judgment as follows:

1. That the Petition for Cancellation be dismissed with prejudice;
2. That Registrant be granted further reasonable and appropriate relief.

Dated: November 20, 2015

Respectfully Submitted,


Christopher Civil
Raj Abhyanker, P.C.
451 N. Shoreline Ave
Mountain View, CA. 94043
Tel. 650.390.6384
Fax. 650.989.2131

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of REGISTRANT'S MOTION FOR RELIEF FROM FINAL JUDGMENT AND MOTION FOR LEAVE TO FILE LATE ANSWER, the DECLARATION OF THOMAS KOENIG, and REGISTRANT'S ANSWER AND AFFIRMATIVE DEFENSES are being served by mailing a copy thereof, by postage-paid U.S. Mail addressed to the following individuals, identified in the Petition for Cancellation as the attorneys of record and correspondents on this 20th day of November, 2015:

MARLENE J WILLIAMS
NIXON PEABODY LLP
ONE EMBARCADERO CENTER, STE 1800
SAN FRANCISCO, CA 9411

and a courtesy copy via email to:

sftrademarks@nixonpeabody.com

mwilliams@nixonpeabody.com

dlabaria@nixonpeabody.com

/s/ Chris Civil

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Attorneys for Registrant